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In re Application : **OFFICE OF PETITIONS**
Wang :
Application No. 09/865,294 : PATENT TERM ADJUSTMENT
Filed: May 25, 2001 :
Dkt. No.: 1151-4167 :

This is a decision on the "REQUEST FOR ADJUSTMENT OF PATENT TERM PURSUANT TO 35 U.S.C. § 1.154 AND REDUCTION OF ISSUE FEE FOR SMALL ENTITY," filed October 6, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **GRANTED IN PART**.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **DISMISSED IN PART**.

The Office will adjust the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance and Issue Fee Due reflects an adjustment of 56 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicant requests that the Determination of Patent Term Adjustment be corrected from 0 days as indicated on the Determination of Patent Term Adjustment mailed July 7, 2004 to 386 days.

A review of the application history reveals that an adjustment of 56 days under 37 C.F.R. § 1.702(a)(1) can be attributed to the Office. In accordance with 37 CFR 1.703(a)(1), the adjustment began July 26, 2002, the date that is fourteen months after the filing date of the application, and ended September 19, 2002, the date the Restriction Requirement was mailed.

Applicant argues that the mailing of the Restriction Requirement(s) was not a "notification under 35 U.S.C. § 132 as set forth by 35 U.S.C. § 154." Applicant further argues that the non-final Office action mailed July 1, 2003 was the first

notification under 35 U.S.C. § 132 mailed by the Office and that as such, the application is entitled to a PTA beginning July 26, 2002, the date that is fourteen months after the filing date of the application, and ending July 1, 2003, the date the non-final Office action was mailed, resulting in a PTA of 298.

Applicant is advised that the mailing of a Restriction Requirement is an action issued as a result of examination conducted pursuant to 35 U.S.C. 131. As such, the mailing of a Restriction Requirement is a notification under 35 U.S.C. 132. See, MPEP 2731. Accordingly, applicant's request for an additional PTA of 298 days is **DISMISSED**.

The Office errantly calculated the period of time for response to the final Office action from the date the original final Office action was mailed, i.e., January 5, 2004. It is acknowledged, however, that the finality of the final Office action mailed January 5, 2004 was withdrawn in the final Office action resetting the period of time for response mailed April 29, 2004. Accordingly, the response to the final Office action mailed April 29, 2004 was timely received June 4, 2004. Thus, there was no failure by applicant to engage in reasonable efforts to conclude prosecution, as argued by applicant.

Accordingly, the application for PTA is hereby **GRANTED** to the extent the PTA of 56 days was previously reduced 60 days for applicant's failure to engage in reasonable efforts to conclude prosecution.

Applicant further argues that an additional adjustment of 88 days is proper relative to the re-mailing of the final Office action. Applicant has presumably calculated the adjustment from February 2, 2004, the day after the date that is four months from the date a response to the non-final Office action submitted, and to April 29, 2004, the mail date of the final Office action restarting the period of time for response.

Applicant is advised that the re-mailing of the final Office action on April 29, 2004 does not alter the date for this application. In the fact that the previously mailed final Office action stopped the four month Office reply request.

Accordingly, applicant's request under 37 CFR 1.704(b) for an additional PTA of 88 days relative to the timeliness of the final Office action is **DISMISSED**.

For the reasons set forth herein, the application is entitled to a patent term adjustment of 56 days.

The required fee of \$200.00 for an application for patent term adjustment has been charged to Deposit Account No. 13-4500 as authorized in the instant application.

This application is being forwarded to the Office of Patent Publication for processing into a patent and for consideration of applicant's request for reduction of issue fee for small entity.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

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Enclosure: Copy of Adjustment PAIR Calculation